

Case 7021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Owen PATTERSON

Serial No.: 09/97,331

Filed: October 16, 2001

For: GOLF PUTTING PRACTICE DEVICE

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BRIEF ON APPEAL

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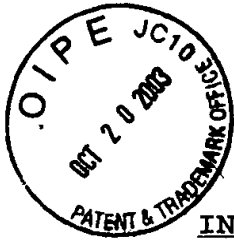
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BRIEF ON APPEAL

Honorable Commissioner of Patents
and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

I. INTRODUCTION

A Notice of Appeal was filed on May 20, 2003 appealing the examiner's final rejection of claims 1, 2, 4-7, 10-19, 21 and 22 as set forth within the Official Action mailed February 20, 2003.

A check in the amount of \$640.00 is attached for payment of the \$165.00 government fee for filing of this Brief and for payment of the \$475.00 government fee for a three-month extension of time extending the due date for filing of this Brief from July 20, 2003 to October 20, 2003. Small entity status has been previously established.

It is believed no additional fee is due; however, if this determination is not correct, debit the deficiency to Deposit Account No. 19-2105 and notify the undersigned in due course.

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Appellant submits the examiner erred in finally rejecting claims 1, 2, 4-7, 10-19, 21 and 22. It is respectfully requested the rejection be reversed and this application be forwarded for issuance without delay.

II. STATEMENT REGARDING REAL PARTY IN INTEREST

The real party in interest is the inventor.

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III. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which directly affect or are directly affected by or have a bearing on the Board's decision in the present appeal.

IV. STATUS OF THE CLAIMS

The application as filed comprised claims 1-22.

In a first Official Action mailed July 30, 2002, all claims were rejected except for dependent claims 3, 8, 9 and 20 which were objected to but held allowable if rewritten into independent format to include all limitations of the preceding claims.

A Response and Request for Reconsideration was filed on October 30, 2002 and an interview was conducted November 19, 2003. A Supplemental Response was then filed in reply to certain issues raised by the examiner during the interview.

A second Office Action mailed February 20, 2003 restated the rejection of claims 1, 2, 4-7, 10-19, 21 and 22 as set forth in the first Office Action.

All rejected and objected pending claims in this application are appealed herein. A summary of the status of these claims is as follows:

- (a) Claims 1, 2, 6, 7 and 19 are rejected under 35 U.S.C. 102(e) as anticipated by Wagner (Des. 444,529).
- (b) Claim 4, 5, 10-16, 18, 19 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner.
- (c) Claim 3, 8, 9 and 20 are objected to as being dependent upon a rejected claim.

V. STATUS OF AMENDMENTS

No amendments have been filed subsequent to issuance of the final office action mailed February 20, 2003.

VI. SUMMARY OF THE INVENTION

Appellant's invention is a device for improving the putting stroke of a golfer.

The device is a target adapted to mimic the hole on a putting green (specification at page 7, line 20). The target is placed on the ground (either outdoors or indoors) a selected distance from the golfer who then putts a golf ball towards target in an effort to strike it (page 7, lines 18-21). In the event the putted golf ball contacts against the target, the device will convey visual information to the golfer corresponding to velocity and direction of travel of the golf ball (page 3, lines 8-14; page 4, lines 1-3; page 7, lines 21-24; and page 8, lines 1-5). This information is useful to the golfer in

adjusting or otherwise correcting his putting stroke.

The above described putting practice device as defined in claim 1 comprises a disc (D) having an annular bottom portion (4), an annular top portion (2) and an annular central portion (extending between 2 and 4), the bottom and top portions being substantially similar in height (page 5, line 10). The central portion includes an annular outwardly extending member (18) extending from the bottom to the top portions and forms in cross section a substantially truncated conical configuration or cone (page 6, lines 17-20). The invention defined in claim 7 provides a bore (8) extending from the top portion through the bottom portion, the bore having top and bottom shoulders (15 and 15"). The invention defined in claim 17 provides the top and bottom annular portions are mirror images (page 5, lines 9-10 and figures 1 and 2) of each other.

VII. ISSUES ON APPEAL

Appellant's appeal of the final rejection of claims 1, 2, 4, -7, 10-19, 21 and 22 as set forth in the final Office Action mailed February 20, 2003 raises the following issues:

- (a) Whether the examiner erred in rejecting claims 1, 2, 6, 7 and 19 under 35 U.S.C. 102(e) as anticipated by Wagner (Des. 444,529).
- (b) Whether the examiner erred in rejecting claims 4, 5, 10-16, 18, 19 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner.

VIII. GROUPING OF CLAIMS

Appellant submits the claims on appeal do not stand or fall together.

IX. ARGUMENT

Applicable Law

The rejections are based upon 35 U.S.C. §§ 102(e), 103(a).

The Legal Standard of Anticipation

MPEP § 2131 provides a claim is anticipated if and only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claims." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claims.

There can be no differences between the claimed invention and the disclosure as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991).

The Legal Standard of Obviousness

To establish a *prima facie* obviousness, the examiner must satisfy three basic requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Skinner*, 2 USPQ2d 1788, 1790 (Bd. Pat. App. & Int. 1986).

Second, the proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991) [While the idea of using a monkey gene to probe for a homologous human gene may have been "obvious to try", many pitfalls existed that would have eliminated a reasonable expectation of successfully obtaining the EPO gene. "Hindsight is not a justifiable basis on which to find that ultimate achievement of a long sought and difficult goal was obvious."].

Third, the prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970). The teachings and suggestions as well as the expectation of success, must come from the prior art and not applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

The Anticipation Rejection

Claims 1, 2, 6, 7 and 17 have been rejected under 35 U.S.C. §102(e) as anticipated by the ornamental design illustrated in Wagner. It is asserted Wagner discloses the structure recited in these claims and that Wagner "may be used for the claimed purpose". Figure 6 of Wagner is stated to disclose the truncated cone recited in claim 2.

The Obviousness Rejection

Claims 4, 5, 10-16, 18, 19 21 and 22 are rejected under 35 U.S.C. §103(a) as unpatentable over Wagner. For this rejection it is stated the weight and dimensions of the golf ball capture disc design shown in Wagner is dependent upon "the durability desired and the number of golf balls one wished to be able to collect in a single pass" and because applicant has not shown "unexpected results of the claimed dimensions" the "claimed dimensions would not have been unobvious to the ordinarily skilled artisan".

Appellant's Position

1. Wagner does not provide an enabling disclosure for a target and therefore cannot be an anticipating reference for a putting device.

2. Wagner fails to disclose all limitations of the claims and therefore cannot anticipate the claims.

3. There is no prior art basis for the modification to Wagner.

4. Wagner as modified in the rejection fails to disclose all limitations of the claims.

EXAMINER'S REJECTION UNDER 35 U.S.C. § 102

**A. THE EXAMINER ERRED IN REJECTING
CLAIMS 1, 2, 6, 7 AND 17 UNDER 35
U.S.C. 103 AS ANTICIPATED BY WAGNER**

1. Grouping of the claims

Claim 6 stands or falls with claims 1, the remaining claims do not stand or fall together.

2. The Examiner's Position

With respect to the structure recited in claims 1, 6, 7 and 17 the examiner states Wagner "discloses the claimed structure" without further explanation. As to claim 2, the examiner states the figure 6 cross-sectional view of Wagner discloses the claimed structure.

1. Wagner Lacks An Enabling Disclosure For Anticipation.

Wagner discloses various views of a golf ball capture disc. A capture disc is a part of a golf ball retrieving assembly which is used to collect golf balls from a driving range. The cited references in Wagner disclose a golf ball retrieving assembly (U.S. 5,882,169 to Tucek) which is shown to comprise a series of vertically aligned capture discs on a trailer assembly. As the trailer is towed along

the driving range, golf balls are 'captured' between adjacent discs.

The drawings and figure description of Wagner only disclose vertical alignment of the capture disc as used in the retrieving assembly. See for example the front elevational view in figure 4 of Wagner and the top plan view in figure 2 of Wagner. The examiner has previously conceded the Wagner figure descriptions enable for a capture disc of a golf ball harvesting and retrieving assembly. See Interview Summary Record dated November 19, 2002.

To constitute an anticipatory reference, the prior art must contain an enabling disclosure. *Chester v. Miller*, 15 USPQ2d at 1336 (Fed. Cir. 1990). An anticipatory reference provides an enabling disclosure if a person of ordinary skill in the art to which the invention pertains could have combined the description of the invention in the prior art reference with *his own knowledge of the art and thereby place himself* and the public in possession of the invention (emphasis added). *In re Donohue*, 226 USPQ 619 (Fed. Cir. 1985).

As noted above, Wagner enables for a capture disc used on a golf ball retrieving assembly wherein golf balls are captured between adjacent pairs of discs as the assembly rolls along a driving range. A person of ordinary skill in the *putting practice* art could not reasonably be said to combine the description of the capture disc shown in Wagner with his or her own knowledge of the practice putting art and thereby place the public in possession of the claimed putting target. Why? Because nothing in Wagner enables for use of the disc

in any manner other than as a vertically aligned capture disc in a harvesting assembly. The rejection is improper and must be withdrawn.

In his continuing refusal to acknowledge the deficiency of Wagner in providing an enabling disclosure within the meaning of 35 U.S.C. Section 102(e), the examiner cites *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto* 136 USPQ 458, 459 (CCPA 1963).

Applicant has carefully reviewed these decision however neither is relevant to the issue of whether the Wagner *prior art reference is sufficiently enabling* so as to provide the minimum requirements of *prima facie* anticipation. The examiner reliance on these cases suggests he misunderstands applicant's position; namely, because Wagner does not provide an enabling disclosure for anything other than a vertically aligned capture disc of a golf ball harvester, *prima facie* anticipation does not exist. The burden of establishing anticipation remains with the examiner. The *Casey* and *Otto* decisions concern an applicant arguing differences in utility between the claimed invention and the prior art is evidence of nonobviousness. Applicant in this appeal makes no such argument regarding nonobviousness. The cited decisions are not relevant.

In addition, the examiner asserts *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997) provides authority to use Wagner as an anticipatory reference even though there is no enablement in Wagner for a putting target. However, the *Schreiber* decision is easily distinguished from the facts of the present application. In *Schreiber*, both the prior

art. device and the claimed device were dispensers (oil and popcorn respectively) and the court had little trouble in holding an oil dispenser enabled for use as a popcorn dispenser. More significantly, the court found that *nothing in the disclosure of the prior art reference suggested it was limited for use as an oil dispenser.* Id. at 1433.

Turning to the present case, the capture disc of Wagner depicted in the front elevation view cannot teach or suggest placing the disc on its side. Further, the Tucek reference cited in Wagner discloses the use of the device within the golf ball collection assembly. The disclosure of Wagner enables only for use as a vertically aligned capture disc. A capture disc does not enable for a putting target. Because the capture disc of Wagner is not enabling for a use other than to (together with additional discs) grab golf balls, it is not an anticipatory reference and anticipation has not been established. The rejection is improper.

2. Wagner does not disclose all limitations in the claims.

Wagner fails to disclose all elements as recited in claims 1, 2, 7 and 17 and therefore cannot anticipate these claims.

Claim 1 recites a central portion having an annular outwardly extending member extending from said bottom and top portions and forming in cross-section a substantially truncated conical configuration. See the truncated annular ring member 18 of figures 1 and 2 of applicant's drawings. The annular outwardly extending member

of Wagner does not illustrate a substantially truncated conical configuration in cross-section. Specific attention is directed to figure 6 of Wagner. The end of the annular outwardly extending member in Wagner is clearly extended, not truncated.

Claim 2 recites the truncated conical cone has a substantially flat surface. See the substantially flat surface 22 shown in figures 1-3 of applicant's drawings. As can be seen in figure 6 of Wagner, the leading edge of the capture disc is not substantially flat or even somewhat flat within the meaning of applicant's disclosure.

Claim 7 recites a bore which extends from the top portion of the disc to the bottom portion has top and bottom shoulders. See shoulders 12 and 16 in figure 2 of applicant's drawings positioned at the openings on either end of the central bore. As can be seen in figure 6 of Wagner which is a section taken along line 6-6 of figure 3, no top and bottom shoulders are provided in association with the bore.

Claim 17 recites the top portion (2) and the bottom portion (4) are mirror images of each other. As is readily apparent, the top and bottom of Wagner are not mirror images as claimed.

The rejection with respect to claims 1, 2, 7 and 17 is improper because every element as set forth in these claims is not found in Wagner, nor arranged as required in the claims.

EXAMINER'S REJECTION UNDER 35 U.S.C. § 103

B. THE EXAMINER ERRED IN REJECTING
CLAIMS 4, 5, 10-16, 18, 19, 21
and 22 UNDER 35 U.S.C. 103 AS
OBVIOUS OVER WAGNER

1. Grouping of the claims

There is no claim grouping with respect to this rejection.

2. The Examiner's Position

Claims 4, 5, 10-16, 18, 19 21 and 22 are rejected under 35 U.S.C. §103(a) as unpatentable over Wagner. It is stated the weight and dimensions of the golf ball capture disc design shown in Wagner is dependent upon "the durability desired and the number of golf balls one wished to be able to collect in a single pass" and because applicant has not shown "unexpected results of the claimed dimensions" the claimed dimensions would not have been unobvious to the ordinarily skilled artisan.

1. There is no prior art basis the modification to Wagner.

It is stated the weight and dimensions of the golf ball capture disc design shown in Wagner is dependent upon "the durability desired and the number of golf balls one wished to be able to collect in a single pass".

The weights and dimensions recited in the claims control the degree of tip of the practice device. See applicant's specification, page 6, lines 3-4; page 8, lines 12-15.

Wagner fails to provide disclosure regarding durability or lifting efficiency. Wagner's disclosure is limited to an ornamental design for a golf ball capture disc. One of ordinary skill, upon viewing the disclosure of Wagner, would not be motivated to modify the weight, height, width, angle or diameter of Wagner since these features are not disclosed.

Even assuming for purpose of argument that the weight, height, width, angle and diameter of Wagner may be modified to change the durability or lifting efficiency of the device, the examiner provides no explanation for why *the claimed* weights and dimensions which are for purposes of tilting a putting practice device would change the durability and lifting efficiency of the Wagner device. For example, upon what scientific basis or principal does the examiner rely in concluding a lifting disc weight of 30 to 50 grams weight and as recited in claim 4 would result in improved durability or lifting efficiency? Why would modification to the truncated conical angle (assuming there is even such a structure in Wagner) between 10 to 20 degrees result in lifting more golf balls? The examiner provides no *prior art* suggestion that there is a relation between the claimed weights and dimensions and durability and efficiency.

The rejection is based upon nothing more than hindsight reconstruction or "obvious to try" reasoning and as noted earlier, such reasons cannot properly form a basis for *prima facie* obviousness. *In re Fine* at 1598. The rejection must be withdrawn.

2. Wagner as modified in the rejection fails to disclose all limitations of the claims.

Prima facie case obviousness requires all the claim limitations be taught or suggested by the prior art. In *re Royka*, 180 USPQ 580, 583 (CCPA 1974).


As noted above in Section A(2), Wagner fails to disclose certain limitations recited in claim 1. Accordingly, because claims 4, 5, 10-16, 18, 19 21 and 22 depend from claim 1, the rejection is improper because these claims likewise fail to disclose all features of the claims; namely, a central portion having an annular outwardly extending member extending from said bottom and top portions and forming in cross-section a substantially truncated conical configuration.

X. CONCLUSION

For all the foregoing reasons, appellant submits the examiner erred in finally rejecting claims 1, 2, 4-7, 10-19, 21 and 22. Appellant respectfully submits the final rejection mailed February 20, 2003 be reversed in all respects.

Respectfully Submitted,

Date: OCTOBER 20, 2003


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XI. APPENDIX

1. A practice putting device comprising:
 - a) a disc;
 - b) an annular bottom portion;
 - c) an annular central portion;
 - d) an annular top portion;
 - e) said annular bottom and annular top portion being substantially similar in height;
 - f) said central portion having an annular outwardly extending member extending from said bottom and top portions and forming in cross section a substantially truncated conical configuration.
2. A practice putting device as in claim 1, wherein:
 - a) said truncated conical cone has a substantially flat surface.
3. A practice putting device as in claim 2, wherein:
 - a) said substantially flat surface includes an annular bead.
4. A practice putting device as in claim 1, wherein:
 - a) said disc having a weight of about from 30 grams to about 50 grams.

5. A practice putting device as in claim 4, wherein:
 - a) said weight is about 39 grams.
6. A practice putting device as in claim 1, wherein:
 - a) a bore extending from said top portion through said bottom portion.
7. A practice device as in claim 6, wherein:
 - a) said bore has top and bottom shoulders.
8. A practice device as in claim 6, wherein:
 - a) said bore has at least one insert.
9. A practice device as in claim 7, wherein:
 - a) said shoulders each have at least one insert position thereon.
10. A practice device as in claim 1, wherein:
 - a) said truncated conical angle is about from 10 degree to about 20 degree.
11. A practice device as in claim 10, wherein:
 - a) said truncated conical angle is about 15 degree.
12. A practice device as in claim 1, wherein:
 - a) said disc height is about from 1.10 inch to about 1.20 inch.

13. A practice device as in claim 12, wherein:
 - a) said disc height is about 1.15 inch.
14. A practice device as in claim 1, wherein:
 - a) said widest diameter is from about 2.50 inches to about 2.80 inches.
15. A practice device as in claim 14, wherein:
 - a) said widest diameter is about 2.68 inches.
16. A practice device as in claim 10, wherein:
 - a) said top and bottom portions are irregular.
17. A practice device as in claim 1, wherein:
 - a) said top portion and said bottom portion are shown to be mirror images each other.
18. A practice device as in claim 6, wherein:
 - a) said bore has a depth from about 0.16 inch to about 0.57 inch.
19. A practice device as in claim 18, wherein:
 - a) said depth is preferred 0.35 inch.
20. A practice device as in claim 3, wherein:
 - a) said flat surface a extending said bead a distance from about 0.015 inch to about 0.9 inch.

21. A practice device as in claim 20, wherein:

a) said distance is preferred 0.03 inch.

22. A practice device as in claim 1, wherein:

a) said putting device has a diameter less than the size of an actual cup on a green by about the diameter of a standard golf ball.

CASE LAW

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